

### REMARKS

This is in response to the Office Action mailed on May 5, 2004, and the references cited therewith.

The numbering for claims 66-68 is amended. Specifically, the claim set as filed included an error in the claim numbering, in that two consecutive claims were numbered 65. Accordingly, claims 66 – 68 have now been correctly numbered. As a result, claims 1-68 are now pending in this application.

#### §103 Rejection of the Claims

Claims 1-67 were rejected under 35 USC § 103(a) as allegedly being obvious over Dimitriadis et al. (U.S. 5,664,948, hereinafter Dimitriadis)

According to the MPEP at 706.02(j), “To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

Claim 1 of the present application requires, *inter alia*, the following:

“determining expected values relating to each user being online during a given time period; and

generating an ordered list of the items of content to be selectively delivered to the users based on the expected values, said ordered list being prioritized to meet delivery requirements associated with said items of content.”

Dimitriadis fails to teach or suggest at least the above limitations, and accordingly a *prima facie* case of obviousness has not been established. Specifically, Dimitriadis discloses the following:

1. “An advertisement presentation block 104 receives from microprocessor 60 an index value and has direct access to the memory resource 90 for presentation of advertisements stored therein. Thus, microprocessor 60 queues advertisement presentation by providing a sequence of index values to the advertisement presentation block 104. The advertisement presentation block, in turn, accesses memory resource 90 by reference to a queued index value and collects the requested advertisement record 400 for presentation. As may be appreciated, message presentation block 104 reacts to the record 400 data type to determine how the advertisement data is to be interpreted and presented, i.e., selects one or both of display 100 and speakers 70 for presentation. Thus, advertisement presentation block 104 may deliver text type data taken from a record 400 to display 100 for presentation thereon, or may employ digitized sound data to produce an audio signal suitable for application to amplifier 68 and presentation on speakers 70. Additionally, advertisement presentation block 104 may be provided with, for example, text-to-speech conversion capability for presentation of text type data found in one of records 400 upon speakers 70. In any case, advertisement presentation block 104 responds to the content, i.e., data type, of each record 400 queued for presentation and selects an appropriate mode of presentation by way of display 100 or amplifier 68 and speakers 70.” Dimitriadis, col.5, ll. 7- 31.

2. “Condition list 400b for each record 400 provides a set of conditions indicating presentation of the associated advertising information. For example, condition list 400b includes a schedule of presentation, a time of presentation, a location such as longitude and latitude where associated products or services are available, or a device 40 event such as power-up. By scanning the condition lists 400b for a collection of records 400 and comparing such conditions to current detected conditions, device 40 determines when a given advertisement stored in device 40 need be presented.” Dimitriadis, col.5, l.66 – col. 6, l.8

3. Further, "[d]ecision block 710 detects the PRESENT command 500. If the PRESENT command 500 is detected, then processing branches through block 712 where microprocessor 60 queues for presentation the corresponding advertisement, i.e., provides to the advertisement presentation block 104 the index value provided by the index parameter of PRESENT command 500c. Command processing terminates following block 712." Dimitriadis, col.8, ll. 19-26.

4. Also, "[t]hus, processing begins in block 800 where microprocessor 60 collects current conditions, i.e., current time, current vehicle location, power-up, and the like. Continuing to block 802, microprocessor 60 scans records 400, i.e., scans condition lists 400b in records 400, for qualifying advertisements as indicated in decision block 804. Upon a condition list 400b member matching a current condition, processing branches to block 806 where, for each condition match, the associated index value is queued for presentation, i.e., delivered to advertisement presentation block 104. Thus, the process of detecting current conditions and queuing qualifying records 400 continues as a background process causing presentation of advertisement information in response to an associated condition required for presentation." Dimitriadis, col.9, ll. 6-20.

Dimitriadis does not teach or suggest "determining expected values relating to each user being online during a given time period" or generating an ordered list "based on the expected values". The Office Action acknowledges that Dimitriadis lacks an explicit recitation of "online during a given time period", and then goes on to contend that this reference "implicitly" shows the same.

Applicants strongly disagree that there is any disclosure (explicit or implicit) of generating expected values, based on which an ordered list is generated, much less expected values related to a user being online during a given time.

At a high level, Dimitriadis provides no disclosure regarding a communications or computer network, or of a user being able to connect to such a network to even be "online".

Dimitriadis clearly does not describe a user as being connected to a computer, or to a computer or communications network. All communications to a user system are described as occurring via a radio broadcast system (20), which provides coordinated voice and data by radio

signal. Figure 1 of Dimitriadis is also described as showing a global positioning system (GPS). A travel information device (40) captures and stores selected portions of voice and data broadcasts. Clearly, the travel information device described by Dimitriadis is never "online".

As will be noted from the above text quoted from Dimitriadis, Dimitriadis discloses storing a condition list (400b), against which current detected conditions are compared to determine whether an advertisement should be presented. Specifically, in the event that a match is found between an item of the condition list and current conditions, an index value associated with the advertisement is queued for presentation.

As such, Dimitriadis discloses, at most, creating a queue of index values, corresponding to advertisements, the queue being constructed responsive to detected current conditions.

Claim 1 of the present application, on the other hand, requires generating an ordered list of items of content, to be selectively delivered to users, based on expected values. These expected values relate to each user being online during a given time. Assuming that the Office Action is equating the creation of queue disclosed in Dimitriadis to the generation of the "ordered list", as required by claim 1 of the present application, the generation of the "ordered list" is independent of current conditions, and is not performed responsive to the detection of any current conditions. The "ordered list" of claim 1 is generated based on the claimed "expected values", which relate to a user being online during a given time.

Turning now to claim 24 of the present application, this claim requires, *inter alia*, the following:

“determining probability data relating to each user being online during a given time period;

based on the probability data and known prior advertisement deliveries to users, generating an ordered master list of advertisements...”

As noted above, Dimitriadis discloses creating a queue of index values, corresponding to advertisements, responsive to detected current conditions. Claim 24, on the other hand, requires generating an ordered master list of advertisements, based on probability data and known prior

advertisement deliveries to users. The probability data, on which the generation of the ordered master list is based, relates to each of a plurality of Web users being online during a given time period.

The Office Action again concedes that Dimitriadis lacks any “explicit recitation” of “Web users” and “determining probability...” but goes on to state that certain cited disclosures of Dimitriadis implicitly show the same.

Applicants strongly disagree. As Dimitriadis fails to make any disclosure of a computer or communications network, there can be no implicit disclosure of “Web users”, or of determining probability data relating to each of a plurality of Web users being online during a given time frame.

The Office Action also ignores the requirement of claim 24 that the ordered master list of advertisements be generated, based not only on the probability data, but also known prior advertisement deliveries to users. Clearly, there is nothing in Dimitriadis to suggest, implicitly or explicitly, generating an ordered master list based on known prior advertisement deliveries to users.

Independent claims 38, 39, 42, 56 and 60 were rejected for “substantially the same reasons as independent claim 1”. The Office Action fails to recognize certain distinctions between these claims, and specifically that certain claims include limitations that are substantially different from those of claim 1. Merely for example, consider that claim 60 includes the following limitation:

“determining an expected position for the item of content in the series based on the number of online users having the specified characteristics, the probability that a random user having the specified characteristics will be online during the specified time, a predicted session length for the random user, and the time period between deliveries of said items of content...”

Applicants do not believe that claim 60, for example, can be properly rejected for “substantially the same reasons as independent claim 1”, in view of the substantial differences between the limitations of claims 1 and 60.

Nonetheless the Applicants contend that Dimitriadis does not suggest, implicitly or explicitly, the limitations of these further independent claims.

Having presented the above arguments, the Applicants believe that the rejections of the independent claims, and accordingly all dependent claims, under 35 U.S.C. §103(a) as being obvious over Dimitriadis have been addressed, and the withdrawal of these rejections is respectfully requested.

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney André Marais at (408) 333-9972 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 5<sup>th</sup> day of November, 2004.

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